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BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

EXAMINER

SHERR, CRISTINA O

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERHARD DITTRICH

Appeal 2009-1467
Application 09/862,502
Technology Center 3600

Decided:¹ March 30, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Gerhard Dittrich (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 8-29. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.²

THE INVENTION

The invention relates to the cost of field transmitters such as sensors that determine gas pressure in a pipeline. Specification 1:6-19. According to the Specification, “[t]he end customer is actually interested only in the measured value supplied by the sensor. ... Today, the end customer pays for the sensor and not for that which he actually requires, the measured value.” Specification 2: 17-28. The claimed method “provides a simple way of billing the use of the sensor S. The end customer no longer pays for the sensor S, but rather for the number AZ of measured values which he obtains from the sensor S.” Specification 7:17-20.

Claim 8, reproduced below, is illustrative of the subject matter on appeal.

8. A method for providing a measured values for end customers, comprising the steps of:
recording a measured value for a process variable using a sensor S1, S2, S3;

² Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Dec. 26, 2007) and Reply Brief (“Reply Br.,” filed May 13, 2008), and the Examiner’s Answer (“Answer,” mailed Mar. 13, 2008).

transmitting the measured value to a process control system
PLS;
counting the number A of transmission operations; and
calculating the costs for the end customer on the basis of the
number A of the transmission operations.

THE REJECTION

The Examiner relies upon the following as evidence of
unpatentability:

Mulokey	US 4,661,914	Apr. 28, 1987
Shimura	US 6,176,826 B1	Jan. 23, 2001
Budike, Jr.	US 6,904,385 B1	Jun. 7, 2005

The Examiner took Official Notice “that counting the number of
operations is old, well known and necessary in anything having to do with
monitoring and accounting as occurs in both Budike and Shimura.” Answer
3. Mulokey is relied upon as evidence in support of the Official Notice.
Answer 3.

The following rejection is before us for review:

1. Claims 8-29 are rejected under 35 U.S.C. §103(a) as being
unpatentable over Shimura, Budicke, Jr., and Mulokey.

ARGUMENT

According to the Examiner, Shimura discloses “a method for
providing measured values for end customers, comprising the steps of
recording a measured value for a process variable using a sensor S1, S2,
S3.” Answer 3. The Examiner conceded that Shimura does not disclose the
calculating step of the claimed method but cited Budike, Jr. (e.g., col. 7, l. 25
to col. 8, l. 55) as showing “calculating the costs for the end customer on the
basis of the number of the transmission operations” (Answer 3). The

Examiner also took Official Notice that “counting the number of operations is old, well known and necessary in anything having to do with monitoring and accounting as occurs in both Budike and Shimura” (Answer 3, citing Mulokey as evidence). Based on the combination of Shimura, Budike, Jr., and Official Notice (Mulokey), the Examiner found that “[i]t would be obvious for one of ordinary skill in the art to combine the teachings of Budike, Mulokey, and Shimura in order to more easily calculate costs to the consumer. Further, it would be obvious in any event, to utilize the readings obtained by the apparatus in Shimura in order to calculate costs, payment, amounts, etc.” Answer 4.

The Appellant disputes the relevance of Budike, Jr. and argues that “‘counting’ may be old does not mean that counting the number of transmission operations in the context of the claimed invention is either old or obvious.” App. Br. 5. Regarding Mulokey, the Appellant argues that “[c]ounting clocks bits does not ... amount to calculating the number of transmission operations and calculating the costs to the end customer.” App. Br. 5. Finally, the Appellant argues that combining the references would not lead one of ordinary skill in the art to the claimed method whereby costs are calculated for the end customer on the basis of the number A of the transmission operations and thus a prima facie case of obviousness has not been made out. App. Br. 5 and Reply Br. 2.

ISSUE

Has the Examiner established a prima facie case of obviousness for the claimed method whereby costs are calculated for the end customer on the basis of the number A of the transmission operations over the cited prior art?

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Claim construction

1. The method of claim 8 includes the step of “recording a measured value for a process variable using a sensor S1, S2, S3.”
2. The Specification describes “S1, S2, S3” as sensors, a type of field transmitter, that record “by way of example, the process variables temperature T, pressure D and flow F on a particular process component.” Specification 5:3-5. “Examples of such process components are tanks for propellant or fuel.” Specification 7:35-36.
3. The method of claim 8 further includes the steps of “transmitting the measured value to a process control system PLS.”
4. The Specification describes “PLS” as a system for processing data; “e.g., using a data bus system” (Specification 2:7-8).
5. The method of claim 8 also includes the steps of “counting the number A of transmission operations” and “calculating the costs for the end customer on the basis of the number A of the transmission operations.”

The scope and content of the prior art

6. Shimura relates to a home care system.

7. Shimura discloses a patient terminal with a sensor to measure a patient's vital sign. See col. 4, ll. 21-35.
8. Budike relates to a multi-utility energy control system.
9. Budike discloses utility meter sensors. "The utility meter sensors may be retrofit sensors which are attachable to existing utility meters for sensing real time rates from the existing utility meters, and transmitting the real time rates to the central processing unit." Col. 7, ll. 56-60.
10. The Examiner cited col. 7, l. 25 to col. 8, l. 55 of Budike, Jr. as disclosing "calculating the costs for the end customer on the basis of the number of the transmission operations." Answer 3.
11. Col. 7, l. 25 to col. 8, l. 55 of Budike, Jr. does not disclose calculating the costs for the end customer on the basis of the number of the transmission operations. Budike, Jr. discloses there an energy control system comprising utility meter sensors for sensing real time rates from existing utility meters and transmitting the rates to a computer central processing unit. The unit in turn functions with software to automatically correct or eliminate inefficient energy consumption. Budike, Jr. also discloses the control computer can also provide access via a network to search engines whereby a consumer can locate pertinent information and be offered opportunities to achieve energy savings.
12. The Examiner relied on Official Notice that "that counting the number of operations is old, well known and necessary in anything having to do with monitoring and accounting as occurs in both Budike and Shimura." Answer 3.

13. The Examiner cited Mulokey as evidence in support of the Official Notice. Answer 3.
14. Mulokey relates to an energy management controller.
15. Mulokey discloses an energy management controller “that has a programmable computer processor [that] communicates with a plurality of remote stations . . . Each station has a microprocessor or microcontroller that has a counter which counts the clock bits and each station compiles an address count.” Col. 1, ll. 38-45.

Any differences between the claimed subject matter and the prior art

16. The prior art does not expressly describe the claim step “calculating the costs for the end customer on the basis of the number A of the transmission operations.”

The level of skill in the art

17. Neither the Examiner nor the Appellant have addressed the level of ordinary skill in the pertinent art of determining costs to be charged a customer for using a sensor. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

18. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The Examiner relied on Budike, Jr. (e.g., col. 7, l. 25 to col. 8, l. 55) for disclosure of “calculating the costs for the end customer on the basis of

the number of the transmission operations” (Answer 3). FF 10. However, we have found no such disclosure. FF 11.

Accordingly, the evidence in support of the prima facie case of obviousness rests on Shimura’s disclosure of sensors, Budike’s disclosure of transmitting rates (FF 7 and 9), and Official Notice that counting the number of operations is well known. FF 12. (We note that Mulokey, cited in support of the Official Notice, simply describes a microprocessor or microcontroller that has a counter which counts the clock bits. FF 15. The relevance of counting clock bits to the subject matter claimed, i.e., counting transmissions to a process control system of recorded measured values by a sensor for a process variable, is not explained and thus unclear. At best, Mulokey provides an example of counting operations.) The combined prior art fails to address all the limitations in the claims. Specifically, the claim step of “calculating the costs for the end customer on the basis of the number A of the transmission operations” (see independent claims 1 and 26) is not disclosed. Accordingly, there is insufficient factual support for the Examiner’s conclusion that “the claims recite combinations which only unite old elements with no change in their respective functions and which yield predictable results ... [and therefore] the claimed subject matter is obvious [under] *KSR*.” Answer 10.

We find that a prima facie case of obviousness has not been established.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 8-29 under 35 U.S.C. §103(a) as being unpatentable over Shimura, Budicke, Jr., and Mulokey.

DECISION

The decision of the Examiner to reject claims 8-29 is reversed.

REVERSED

ewh

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA VA 22314-1176